

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

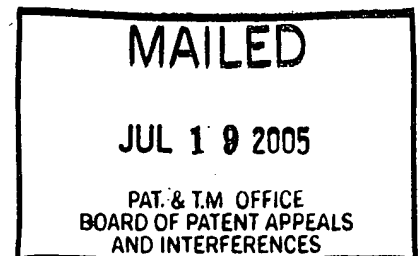
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. HUTCHINS, Jr.

Appeal No. 2005-1135
Application 09/591,112

ON BRIEF



Before FRANKFORT, McQUADE, and NASE, **Administrative Patent Judges.**

FRANKFORT, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 12, 18 through 23, 25, 26, 28 and 31 through 33. Claims 13 and 14, the only other claims remaining

in the application, have been indicated by the examiner to be "allowed" (answer, page 2). Claims 15 through 17, 24, 27, 29 and 30 have been canceled.

As noted on page 1 of the specification, appellant's invention relates generally to a chess game playing array assembly and more particularly to a chess game playing array having multiple playing segments forming playing spaces on which a game of chess may be played. In one arrangement (Figs. 1-5), appellant provides a chess game playing array assembly (10) including a plurality of three-dimensional playing segments (12) disposed relative to one another to define an array of playing spaces (16) on which a game of chess may be played, and wherein the plurality of three-dimensional playing segments are spaced apart by one or more channels or voids (14). As generally depicted in Figure 15, one or more void fillers (e.g., 110) may be disposed in one or more of the above-noted voids. An alternative form of chess game playing array assembly including a plurality of three-dimensional playing segments (132a, 132b) is shown in Figure 16. Figure 18 depicts an embodiment wherein the chess game playing array assembly is embodied on a computer and displayed on a display as a graphical user interface.

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Independent claims 1, 23 and 28 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner are:

Moore	511,306	Dec. 19, 1893
Eplett	4,696,476	Sep. 29, 1987
Calhoun	5,333,878	Aug. 2, 1994
Harris, III (Harris)	Des. 349,521	Aug. 9, 1994
Gaito et al (Gaito)	5,462,281	Oct. 31, 1995
Hullinger	6,279,907	Aug. 28, 2001
Bulbrook	2 229 099	Sep. 19, 1990
(Published UK Patent Application)		

Claims 1, 2, 3, 9, 31 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Calhoun.

Claims 4 through 8, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Bulbrook.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Gaito.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Eplett.

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Claims 19 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Hullinger.

Claims 23, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eplett in view of Moore.

Claims 28 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eplett in view of Harris.¹

Rather than reiterate the conflicting viewpoints advanced by appellant and the examiner regarding the above-noted rejections, we refer to the final rejection (mailed September 12, 2003) and examiner's answer (mailed May 27, 2004) for an exposition of the examiner's position, and to appellant's brief (filed January 26, 2004) for the arguments thereagainst.

¹ As noted on page 2 of the examiner's answer, the rejection of claims 18, 23, 25, 26, 28 and 33 under 35 U.S.C. § 112, second paragraph, set forth on page 2 of the final rejection has now been withdrawn.

OPINION

Having carefully reviewed the anticipation and obviousness issues raised in this appeal in light of the record before us, we have made the determinations which follow.

In rejecting claims 1, 2, 3, 9, 31 and 32 under 35 U.S.C. § 102(b), the examiner urges that Calhoun discloses a game array assembly (Fig. 1) including a plurality of three-dimensional playing segments (19) disposed relative to one another to define an array of playing spaces on which game pieces (e.g., 14, 15, 16) may be placed, and wherein the plurality of three-dimensional playing segments are spaced apart by one or more channels or voids (21). In addition, Calhoun teaches the use of void fillers (11, 12) for forming upstanding walls rising above the playing segments (Figs. 1, 2 and 9). As further depicted in Figure 1, the plurality of three-dimensional playing segments are positioned relative to one another to define a non-rectilinear array of playing spaces. Concerning the fact that Calhoun is directed to a maze type board game, while the claims on appeal are directed to a "chess game playing array assembly" with playing spaces on which chess game playing pieces are selectively

placed when a chess game is being played, the examiner urges that those limitations "are only intended use of the apparatus and do not add further limitation to the apparatus in the claim" (final rejection, page 3).

On pages 8 and 9 of the brief, appellant admits that Calhoun shows "a plurality of three-dimensional playing segments 18, 19, 20 that are spaced apart by voids 21, with void fillers 12 disposed in one or more of the voids each comprising an upstanding wall rising above adjacent playing surfaces for separating the adjacently disposed playing surfaces." However, appellant contends that the playing spaces of Calhoun are not selectively positioned relative to one another so as to define different rectilinear or non-rectilinear arrays of playing spaces on which chess game playing pieces are selectively placed when a chess game is being played. In addition, appellant urges that the specific structural features set forth in dependent claims 3 and 31 on appeal are not taught or suggested in Calhoun.

Looking to appellant's disclosure, and more particularly to that at page 7 beginning at line 20, as highlighted by appellant in the brief, we are of the opinion that the language of claim 1

on appeal regarding a game playing array assembly comprising "a plurality of three-dimensional playing segments that are selectively positioned relative to one another to define a rectilinear or non-rectilinear array of playing spaces" is readable on a game playing array assembly like that seen in either Figures 1-5 or Figure 6 of the present application, wherein the determination of game array apparatus configuration and selection of the position of the three-dimensional playing segments relative to one another to define a rectilinear or non-rectilinear array of playing spaces is decided before fabrication of the game playing array assembly and results in a fixed arrangement and spacing of the three-dimensional playing segments in the final array assembly. We find nothing in appellant's disclosure to support the proposition that the plurality of three-dimensional playing segments (e.g., 12 in Figs. 1-5 or 42 in Fig. 6) are in any way selectively positioned or positionable (i.e., movable) relative to one another to define different rectilinear or non-rectilinear arrays of playing spaces, as appellant appears to be urging in the brief (pages 8-9).

Thus, since we find appellant's argument in the brief concerning claim 1 to be unpersuasive, and since we agree with

the examiner that the game playing array assembly set forth in claim 1 on appeal is readable on that seen in Calhoun, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b).²

Concerning the § 102 rejection of dependent claims 2, 9 and 32, we note that appellant has not argued for the separate patentability of these claims with any reasonable degree of specificity apart from independent claim 1. Thus, we are of the view that claims 2, 9 and 32 will fall with claim 1, and will sustain the examiner's rejection thereof.

Regarding the examiner's rejection of dependent claims 3 and 31 under 35 U.S.C. § 102(b) based on Calhoun, we find that these claims are readable on the game playing array assembly seen in that patent. More particularly, concerning claim 3, we observe that the four separate maze areas (22a, 22b, 22c, and 22d) in

² In reaching this determination, we note that appellant has not disputed or in any meaningful way challenged the examiner's determination (final rejection, page 3) that the recitations in claim 1 regarding a "chess" game playing array assembly with playing spaces on which chess game playing pieces are selectively placed when a chess game is being played, "are only intended use of the apparatus and do not add further limitation to the apparatus in the claim."

Calhoun constitute "a plurality of three-dimensional playing segments that are selectively positioned relative to one another to define a rectilinear or non-rectilinear array of playing spaces" as defined in claim 1 on appeal, and that each of those segments defines two or more playing spaces (18, 19, 20) of the array of playing spaces on which two or more of the playing pieces (14, 15, 16) therein are selectively placed. As for claim 31, this claim sets forth that "the one or more [void] fillers extends around more than one of the playing segments." This aspect of the claimed invention is clearly met when the maze walls or void fillers (11) seen in Figures 1 and 2 of Calhoun are formed of maze wall pieces (12) as is indicated in column 3, lines 19-28 of the patent. Thus, the examiner's rejection of claims 3 and 31 under 35 U.S.C. § 102(b) is sustained.

The next rejection for our review is that of claims 4 through 8, 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Bulbrook. In this instance, the examiner contends that one of ordinary skill in the art at the time of appellant's invention would have found motivation and suggestion in Bulbrook for forming the game playing array apparatus seen in Calhoun to have 64 playing segments as shown in

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Bulbrook "in order to attract the chess-playing enthusiasts towards a game" (final rejection, page 3). The examiner goes on to also indicate that

Calhoun teaches all limitations except that it does not teach placing segments at various elevations. Bulbrook teaches placing segments at various elevations. While there is not criticality illustrated for applicant's game having segments being placed at various elevations, games are often constructed to attract players by their aesthetical appearances. In order to change the aesthetical appearance and for attracting players it would have been obvious to place segments at various elevations to create the look of a stadium or the look of a terrain. One of ordinary skill in art at the time the invention was made would have suggested placing segments at various elevations for aesthetic reasons.

Note that changing the shape (as in applicant's claims 4 and 10) or size of a playing segment is a matter of aesthetical change and does not differentiate the game. In order to make the game attract players, it would have been obvious to change shapes of playing segment. One of ordinary skill in art at the time the invention was made would have suggested variation in shapes to attract players." (final rejection, page 4).

In the portion spanning pages 9 and 10 of the brief, appellant indicates that "at least claims 4, 10 and 11 further patentably distinguish over the cited references," and urges with regard to the examiner's position that "[m]erely stating that a particular claim feature is obvious without adequate factual support is clearly insufficient." Based on these assertions, we look to claims 4, 10 and 11, and consider that the other claims

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subject to this ground of rejection (i.e., claims 5 through 8) are not separately argued and thus are to be considered as falling with claim 1 from which they depend. Accordingly, the examiner's rejection of claims 5 through 8 under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Bulbrook is sustained.

As for claims 4, 10 and 11, we agree with the examiner's findings and conclusions in the final rejection and answer (pages 4-5) concerning claims 4 and 11, but not with regard to claim 10. While the applied references would have been suggestive of playing segments of different shapes (answer, pages 4-5) and of playing spaces having different indicia thereon (broadly "different terrain patterns") to differentiate the various playing space, we find nothing in either Calhoun or Bulbrook, or in the assertions made by the examiner, which would have been suggestive to one of ordinary skill in the art at the time of appellant's invention of the particularly shaped three-dimensional playing segments defined in claim 10. Thus, the examiner's rejection of claims 4 and 11 under 35 U.S.C. § 103(a) is sustained, while that of claim 10 is not sustained.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Gaito. Since the arguments presented on pages 10-11 of the brief do not appear to separately argue for the patentability of claim 12 apart from claim 1, from which it depends, we consider that claim 12 will fall with claim 1. Thus, the examiner's rejection of dependent claim 12 under 35 U.S.C. § 103(a) is sustained.

The next rejection for our consideration is that of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Calhoun in view of Eplett. Claim 18 depends from claim 1 and sets forth the further requirements that the plurality of three-dimensional playing segments

comprise first and second opposing playing segments, each playing segment defining a four row by eight column array of playing spaces such that when disposed relative to one another collectively an eight row by eight column array of playing spaces is formed, wherein the first playing segment includes a different motif than that of the second playing segment that is not a repeat pattern or a reverse repeat pattern of the second playing motif.

Recognizing that Calhoun does not teach or suggest this particular configuration of game playing array assembly, the examiner turns to Eplett urging that it teaches "connecting segments of game to form a game (Fig. 4-6)" and that in the art

area of board games, making boards in segments is commonly known for easy storing purposes. The examiner then concludes that it would have been obvious "to make game board [presumably of Calhoun] in two pieces" for easy storing reasons (final rejection, page 5).

Even assuming that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to make the game board seen in Calhoun in two or more pieces for easy and compact storage, the examiner has not addressed the particular features set forth in claim 18 on appeal concerning the configuration of the first and second opposing playing segments (i.e., each defining a four row by eight column array of playing spaces), or the specific requirement in the claim concerning the different motifs of the first and second playing segments. The examiner's belated attempt in the answer (page 5) to supplement the position set forth in the final rejection is to no avail, since we find no basis in the teachings of Calhoun and Eplett which would have led to a combination of the disparate structures disclosed therein and resulted in the particular game

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playing array assembly defined in appellant's claim 18. Thus, the examiner's rejection of claim 18 under 35 U.S.C. § 103(a) will not be sustained.

In rejecting claims 19 through 22 under 35 U.S.C. § 103(a) based on the collective teachings of Calhoun and Hullinger, the examiner is of the view that it would have been obvious, in light of the teachings of Hullinger, to implement the board game of Calhoun on a computer using appropriate software packages. We agree. Calhoun itself (col. 3, line 3) indicates that the board game therein may be implemented as "a computer simulated image," instead of as hardware involving a real life playing surface formed of wood, plastic, metal, or other material. In concluding that one of ordinary skill in the art would have relied upon logic stored in the computer to receive design parameter inputs, including the number, size and shape of the three-dimensional playing segments, arrangement of playing segments, size and shape of voids, etc., wherein the logic is processed by a processor to display an image of the game playing array assembly on a display, we have presumed skill on the part of the artisan, rather than the converse (see, for example, In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)). Moreover, we observe that

Hullinger (e.g., col. 5, lines 1-31) makes clear that various bitboards and software packages relating to the representation of various quantities of squares (playing spaces or segments), the initial position of all the pieces at the beginning of the game, etc., are needed to implement a board game in a computer format.

Thus, having reviewed and evaluated the combined teachings of the applied Calhoun and Hullinger patents, it is our opinion that there is clear motivation and suggestion in the collective teachings of the applied prior art to make the modification in Calhoun urged by the examiner and to arrive at the subject matter broadly set forth in claims 19 through 22 on appeal. For that reason, we will sustain the examiner's rejection of claims 19 through 22 under 35 U.S.C. § 103(a).

The next rejection for our review is that of claims 23, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Eplett in view of Moore. Independent claim 23 is directed to a chess game playing array assembly like that seen in Figure 16 of the present application, wherein the assembly consists of two opposing playing segments (132a, 132b) that are sloped toward one another and define a plurality of playing spaces on which chess

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game playing pieces are selectively placed when a game of chess is played. The opposing playing segments include first and second motifs having first and second landscape terrain patterns that are different from and not a repeat pattern or a reverse pattern of each other, and include respective topographic geometries that are different from one another and are not a repeat pattern or a reverse pattern of one another. Simply stated, even if it would have been obvious to form the game board of Eplett in two pieces, instead of the four described therein, we see no basis (and the examiner has pointed to none in the rejection) for making the further modifications in Eplett necessary to arrive at the particular chess game playing array assembly set forth in claim 23 on appeal. In fact, we agree with appellant (brief, page 13) that there is a clear disincentive for even attempting to make such modifications of the board game in Eplett (i.e, destroying the nestability of the playing segments as taught and desired in Eplett). Thus, in light of the foregoing, we will not sustain the examiner's rejection of independent claim 23 under 35 U.S.C. § 103(a), or that of claims 25 and 26 which depend therefrom.

The last rejection for our review is that of claims 28 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Eplett in view of Harris. Independent claim 28 is directed to a chess game playing array assembly similar to that seen in Figure 17 of the present application. Like appellant (brief, pages 13-15), absent hindsight, we see nothing in a combined evaluation of the design patent to Harris and the multi-stepped game board of Eplett that would have led one of ordinary skill in the art to modify the sectional game board of Eplett in a manner necessary to arrive at the particular chess game playing array assembly defined in claims 28 and 33 on appeal. For that reason, we will not sustain the examiner's rejection of claims 28 and 33 under 35 U.S.C. § 103(a).

In accordance with the foregoing, the decision of the examiner rejecting claims 1 through 12, 18 through 23, 25, 26, 28 and 31 through 33 of the present application under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) is affirmed-in-part. The rejections of claims 1 through 9, 11, 12, 19 through 22, 31 and 32 having been affirmed, while those of claims 10, 18, 23, 25, 26, 28 and 33 have been reversed.


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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED- IN- PART

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE

~~JEFFREY V. NASE~~
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